

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/987, 380 12/09/97 INOUYE

M Q48500

HM12/0202  
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2100 PENNSYLVANIA AVENUE NW  
WASHINGTON DC 20037-3202

 EXAMINER

WANG, S

ART UNIT	PAPER NUMBER
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1617 **DATE MAILED:**

02/02/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	<b>Application No.</b> 08/987,380	<b>Applicant(s)</b> INOUE ET AL.
	<b>Examiner</b> Shengjun Wang	<b>Art Unit</b> 1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_ .

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-15 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).  
a)  All b)  Some \* c)  None of the CERTIFIED copies of the priority documents have been:  
1.  received.  
2.  received in Application No. (Series Code / Serial Number) \_\_\_\_.  
3.  received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

14)  Notice of References Cited (PTO-892) 17)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
15)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 18)  Notice of Informal Patent Application (PTO-152)  
16)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 & 9 19)  Other: \_\_\_\_\_

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## **DETAILED REACTION**

### ***Claim Rejection 35 U.S.C. 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 4, 6, 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. 4, and 8-9 recited "... the thermosetting resin is prepared from polyisocyanate having tri or higher isocyanate groups **and/or** polyols having tri- or higher hydroxyl groups." It is unclear that what is claimed by applicant, "...the thermosetting resin is prepared from polyisocyanate having tri or higher isocyanate groups **and** polyols having tri- or higher hydroxyl groups," or "...the thermosetting resin is prepared from polyisocyanate having tri or higher isocyanate groups **or** polyols having tri- or higher hydroxyl groups."

4. Claim 6 is vague and confusing in that the claimed method is not clearly defined. Particularly, the meaning of the phrase "repeating the operation" is unclear. Furthermore, the phrase "to be coated in one time" is confusing.

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***Claim Rejection 35 U.S.C. 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Tocker (WO 91/10362).

Tocker teaches a pesticidal granules composition coated with a polyurethane, a thermosetting resin. See, particularly, page 2, line 23-31. The polyol employed has at least two hydroxyl groups and the polyisocyanate has at least one isocyanate substituent (-NCO). See, particularly. Page 4, lines 1-30. The amount of polyisocyanate employed is about 1-20% by weight, and the reaction temperature is at ambient temperature or above. The coating procedure can be carried out stepwise. See, particularly, page 5, line 5-22. Tocker further teaches that, as required by some practice, e.g., slow release of the active component, monomers containing more isocyanate or hydroxyl group may be employed to increase the degree of cross-link in polyurethane. See, particularly, page 10, lines 16-24. Regarding claims 5, 7, 10-15 which recited water absorption ratio of the thermosetting resin is not more than 5%, the limitation is inherent in prior art. Since only alleged distinction between applicants' claim and reference is recited in functional language, it is incumbent upon applicants, when challenged, to show that the polyurethane employed by reference do not actually possess such characteristics. In re Ludtke, 169 USPQ 563.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald E. Adams, Ph.D., J.D., can be reached on (703) 308-0570. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Shengjun Wang

AU 1617

January 25, 2000

  
DONALD E. ADAMS  
SUPERVISORY PATENT EXAMINER